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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,724	04/10/2001	John E. Jones	47171-00283	8425
30223	7590	06/08/2004	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			TAYLOR, APRIL ALICIA	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Alc

Office Action Summary	Application No.	Applicant(s)	
	09/829,724	JONES, JOHN E.	
	Examiner	Art Unit	
	April A. Taylor	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-39, 41, 43-84, 87, 90, 103-107 and 110-133 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-39, 41, 43-84, 87, 90, 103-107 and 110-133 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 20 January 2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 22, 31, 32, 44, 56-60, 65, 71, 73, 80-84, 87, 115, 118, 119, 128, 132, and 133 are rejected under 35 U.S.C. 102(b) as being anticipated by Funk (US 5,832,463).

Re claims 1, 2, 31, 32, 44, 52, 57-60, 65, 71, 73, 80-84, 87, 118, 119, 128, 132, and 133: Funk teaches an automated check processing system comprising:

a document scanner located at a site of a customer transaction comprising:

a slot adapted to accept a document associated with the customer transaction;

means for customer authorizing an agreement for the document to be processed in accordance with an automated account clearing process;

an image scanner acquiring at least one image of the document; and

a MICR reader;

a communication interface coupled to a central document clearinghouse and adapted to communicate the document image following customer authorization of the agreement to the central document clearinghouse for automated account clearing processing of the document; and

wherein the image scanner further obtains field information from the document image, and wherein the communication interface communicates the field information along with the document image to the central document clearinghouse for automated account clearing processing of the document. (See col. 3, line 28 to col. 4, line 36)

Re claim 22: Funk further teaches an input device through which a transaction amount is keyed in, the document scanner further including means for recognizing a transaction amount in the imaged document and adapted to compare the recognized transaction amount against the keyed in transaction amount. (See col. 3, line 28+)

Re claims 56, 115: Funk further teaches adding a transaction amount to the check (see col. 3, line 37-40).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 7, 8, 15, 16, 21, 35-37, 41, 48, 49, 61-64, 120, 121, 125, and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) in

view of Templeton et al (US 6,547,132), (hereinafter Templeton). The teachings of Funk have been discussed above.

Funk also teaches wherein the check may be truncated or marked in some way to indicate that the check has been processed and returned to the customer (see col. 3, lines 65+). However, Funk fails to specifically teach or fairly suggest wherein the means for customer authorizing comprises a printer for imprinting indicia of verbal authorization received from the customer on the check; wherein the means for customer authorizing comprises means for imprinting an authorization agreement for the automated account clearing process on the check or a receipt; a transport mechanism for conveying the check past the printer and returning the check to the customer for execution of the authorization agreement by the customer; and a controller coupled to the transport mechanism.

Templeton teaches a check processing system comprising a printer 24 for imprinting an authorization agreement on the check or a receipt; a transport mechanism for conveying the check past the printer and returning the check to the customer; and a controller coupled to the transport mechanism (see col.5, lines 25-33; col. 6, lines 33-36; and col. 7, lines 12+). In view of Templeton's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known check processing system having a printer, a transport mechanism, and a controller coupled to the transport mechanism to the teachings of Funk in order to provide a physical marking on the check or receipt to indicate that a transaction has been processed and to ensure that authorization was given by the

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customer for future reference. Although Funk as modified Templeton is silent with respect to printing a verbal authorization agreement on the check, it is well known in the art for a point-of-sale cashier to ask a customer if they would like to pay by cash, check, or credit card. Once the customer responds by saying he/she would like to pay by the check, one of ordinary skill in the art would interpret that to be a verbal authorization from the customer. Therefore, it is inherent that the printed authorization agreement could include information regarding a verbal agreement from the customer.

6. Claims 5, 6, 9, 10, 38, 39, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) as modified by Templeton (US 6,547,132) as applied to claims 3, 4, and 7 above, and further in view of Higashiyama et al (US 5,175,682), (hereinafter Higashiyama). The teachings of Funk as modified by Templeton have been discussed above.

Funk as modified by Templeton fail to teach or fairly suggest wherein the imprinting means comprises a stamp for stamping the authorization agreement on the check or receipt; and wherein the stamp further includes a promise to pay as well as the authorization agreement.

Higashiyama teaches a check processing system comprising a stamp for stamping validation information on a check or receipt (see col. 4, lines 26-53). In view of Higashiyama's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known check processing system having a stamp to the teachings of Funk as modified by Templeton in order to provide a backup in the event of printer failure and to provide a

physical marking on the check or receipt indicating that the transaction has been processed and authorization was given by the customer for future reference.

7. Claims 12, 23, 24, 45, 47, 122, and 123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) in view of Templeton et al (US 6,547,132). The teachings of Funk have been discussed above.

Funk fails to teach or fairly suggest wherein means for customer authorizing comprises means for displaying an authorization agreement for the automated account clearing process to the customer.

Templeton teaches a check processing system comprising a display 14 (see figure 1). In view of Templeton's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known check processing system having a display to the teachings of Funk in order to provide additional confirmation to the customer regarding the authorization for the automated account clearing process by displaying the information on the screen.

8. Claims 13, 14, 46, 110, 113, and 124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) as modified by Templeton (US 6,547,132) and further in view of Fernando et al (US 6,193,152), (hereinafter Fernando). The teachings of Funk as modified by Templeton have been discussed above.

Funk as modified by Templeton fail to teach or fairly suggest a check processing system comprising an electronic signature pad and an electronic pen.

Fernando discloses a point of transaction system comprising a signature pad device and a stylus (see figure 1; col. 3, lines 41+). In view of Fernando's teaching, it

would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known signature pad and stylus to the teachings of Funk as modified by Templeton in order to prevent the cashier from removing the check after realizing that the customer forgot to sign the check, which would reduce processing time.

9. Claims 17, 18, 33, 34, 50, 51, 111, 112, 114, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) in view of Higashiyama et al (US 5,175,682). The teachings of Funk have been discussed above.

Funk fails to teach or fairly suggest wherein a printer is adapted to inscribe the check with indicia of cancellation and wherein the slot is adapted to return the canceled check to the customer.

Higashiyama teaches a printer adapted to inscribe the check with indicia of cancellation and wherein the slot is adapted to return the cancelled check to the customer (see col. 4, line 25+). In view of Higashiyama's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known check processing system having a printer adapted to inscribe the check with an indicia of cancellation and a slot adapted to return the canceled check to the customer to the teachings of Funk in order to confirmed that the check have been process and is now considered cancelled for future reference.

10. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) in view of Templeton et al (US 6,547,132). The teachings of Funk as modified by Templeton have been discussed above.

Funk as modified by Templeton fails to teach or fairly suggest a check processing system having a second printer. However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known check processing system having a second printer in order to provide a backup in the event that the first printer fails.

11. Claims 25-30, 53-55, 66-70, 72, 74, 90, and 129-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463). The teachings of Funk have been discussed above.

Re claims 25, 26, 66-70, 72, 129-131: Funk fails to specifically teach or fairly suggest wherein the image scanner further comprises a single scanhead and/or multiple scanheads, the Examiner takes Official Notice that image scanners having a single scanhead or multiple scanheads are well known in the art. Furthermore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known multiple scanheads scanner to teaching of Funk in order to scan a document more efficiently and faster.

Re claims 27 and 67-70: Funk fails to teach or fairly suggest wherein the image scanner comprises a mirror for receiving images of a document. Although Funk doesn't specifically mention that the scanner includes a mirror for receiving images of a document, the Examiner takes Official Notice that document scanners/imagers having a mirror for receiving images of a document is well known in the art.

Re claims 28, 53, 74, and 90: Funk fails to teach or fairly suggest wherein a plurality of documents are scanned and a plurality of document are transmitted by the

communication interface in a batch to the central document clearinghouse. The examiner takes Official Notice that it is well known in the art for check processing system to transmit plurality of documents in batches to the central document clearinghouse. This type of transfer is usually done after regular business hours.

Re claims 29, 30, 54, and 55: Funk fails to specifically teach or fairly suggest wherein the document scanner transports and scans the document such that a longer edge of document is perpendicular to a direction of transport; and wherein the document scanner transports and scans the document such that a longer edge of document is parallel to a direction of transport. It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a document scanner for transporting and scanning the document such that a longer edge of document is perpendicular or parallel to a direction of transport to teaching of Funk, since applicant has not disclosed that choosing a specific one of these transporting methods solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either feature. Thus, it would have been an obvious expedient to provide a document scanner for transporting and scanning the document such that a longer edge of document is perpendicular or parallel to a direction of transport, as it would have been a matter of a design choice of the manufacturer.

12. Claims 75, 78, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463).

Re claims 75 and 78: Funk teaches a document scanner, a processor, a communication interface coupled to a central check clearinghouse; and a MICR data reader.

Funk fails to specifically teach or fairly suggest wherein the image scanner further comprises a single scanhead, the Examiner takes Official Notice that image scanners having a single scanhead are well known in the art. Furthermore, Funk fails to teach or fairly suggest wherein the image scanner comprises a mirror for receiving images of the document. The examiner takes Official Notice that document scanners/imagers having a mirror are well known in the art.

Re claim 79: Funk fails to teach or fairly suggest wherein the document scanner obtains a plurality of image files and the communication link communicates the images in a batch to the central check clearinghouse. The examiner takes Official Notice that it is well known in the art for checking processing system to transmit a plurality of image files in batches to the central check clearinghouse. This method of transmitting files is usually done after regular business hours.

13. Claims 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) in view of Templeton et al (US 6,547,132). The teachings of Funk have been discussed above.

Funk fails to teach or fairly suggest a printer adapted to print an agreement on the checks and inscribe a transaction amount on the check.

Templeton teaches a printer adapted to print an agreement on the checks and inscribe a transaction amount on the check. In view of Templeton's teaching, it would

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have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the well known check processing system having a printer to the teachings of Funk in order to provide a physical marking on the check to indicate that a transaction has been completed and to ensure that authorization was given by the customer for future reference.

14. Claims 103-107, 116, and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk (US 5,832,463) in view of Templeton et al (US 6,547,132).

Re claims 103, 104, 116, and 117: Funk teaches a document scanner comprising a document image scanner; a processor; a memory; and a communication interface.

Funk fails to teach or fairly suggest a printer adapted to print an agreement on the checks and inscribe a transaction amount on the check; a transport mechanism for returning the checks with imprinted agreement to the customer; and a controller coupled to the transport mechanism.

Templeton teaches a printer adapted to print an agreement on the checks and inscribe a transaction amount on the check; a transport mechanism for returning the checks with imprinted agreement to the customer; and a controller coupled to the transport mechanism. In view of Templeton's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the well known check processing system having a printer to the teachings of Funk in order to provide a physical marking on the check to indicate that a transaction has been completed and to ensure that authorization was given by the customer for future reference.

Re claims 105 and 117: Funk as modified by Templeton fails to teach or fairly suggest wherein the document scanner comprises a single scanhead. The examiner takes Official Notice that image scanners having a single scanhead are well known in the art.

Re claim 106: Funk as modified by Templeton fails to teach or fairly suggest wherein the document image scanner comprises a first and a second scanhead. The examiner takes Official Notice that image scanners having a first and a second scanhead are well known in the art. Furthermore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the well known image scanners having a first and a second scanhead to the teachings of Funk in order to scan a document more efficiently and faster.

Re claims 107 and 117: Funk fails to teach or fairly suggest wherein the image scanner comprises a mirror for receiving images of the document. The examiner takes Official Notice that document scanners/imagers having a mirror are well known in the art.

Response to Arguments

15. Applicant's arguments with respect to claims 1-10, 12-39, 41, 43-84, 87, 90, 103-107 and 110-133 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

16. The following US Patents have not been considered since they were cited by the examiner on the PTO-892 form in a previous Office Action (see paper nos. 5 and 8).

US Pat. No. 5,832,463 to Funk US Pat. No. 5,940,844 to Cahill et al

US Pat. No. 6,038,553 to Hyde, Jr. US Pat. No. 6,283,366 to Hills et al

US Pat. No. 6,354,491 to Nichols et al US Pat. No. 6,473,519 to Pidhirny et al

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Norton (US 6,243,689) discloses a system for authorizing electronic funds transfer at a point of sale.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.taylor@uspto.gov].

All Internet e-mail communications will be made of record in the

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application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


April Taylor
31 May 2004



THIEN M. LE
PRIMARY EXAMINER